

## STATUS OF THE CLAIMS

Claims 1-8 are pending in the application.

Claims 1 and 5 were rejected under 35 USC§102 as being anticipated by Franz '318 (US Patent 5,042,318).

Claims 2, 3, 6 and 7 were rejected under 35USC§103(a) as being unpatentable over Franz '318 in view of Matsumura et al. '340 (US Patent 5,055,340).

Claims 2, 4, 6 and 8 were rejected under 35USC§103(a) as being unpatentable over Franz '318 in view of Gabbrielli '807 (EP 1216807A2).

## **REMARKS**

### **Summary of the Invention**

An adjustable wrapping device comprising a flexible sheet of a compressible elastomer having a textured, non-slip surface and a smooth opposing surface, said smooth opposing surface being laminated to a sheet of a substantially non-extensible reinforcing fabric to form a laminated sheet. The laminated sheet further includes fastening means affixed to the laminated sheet, said fastening means being operable for releasably attaching opposing ends of said lamintated sheet to one another to form a cylindrical tube. A colored fabric is preferably affixed to at least one peripheral edge of the laminated sheet.

### **The Rejection Under 35USC§102**

Claims 1 and 5 were rejected under 35 USC§102 as being anticipated by Franz '318 (US Patent 5,042,318). Briefly, Franz '318 discloses a steeringwheel cover wherein an inner "resilient" material having a gripping steering wheel-facing surface is bonded to an

outer “resilient” material having a smooth surface that is comfortable to grip. The layer of resilient material cannot be nonextensible because the diameter of the toroidal cover of Franz is less than the diameter of the steering wheel. Accordingly, the cover of Franz must be stretched in order to enclose the steering wheel. A nonextensible fabric cannot be stretched and therefor cannot be used as a layer in the cover of Franz.

In contrast, the present invention discloses and claims a wrapping device wherein a layer of compressible material is laminated to a layer of a nonextensible fabric. As discussed above, the cover of Franz would be inoperable for its intended function if the cover included a layer of nonextensible fabric. In order for a patent to qualify as a reference supporting a §102 (b) rejection, it must disclose each and every limitation of the rejected claim. It is settled that even only slight differences between the compared inventions prevent a rejection based on lack of novelty under §102. Anticipation under 35 USC§102 requires that the cited references demonstrate each and every element of the claimed invention. In view of the differences between the elements of the present invention and those of the prior art presented herein, it is requested that this rejection be withdrawn.

#### The Rejection Under 35USC§103

Claims 2, 3, 6 and 7 were rejected under 35USC§103(a) as being unpatentable over Franz ‘318 in view of Matsumura et al. ‘340 (US Patent 5,055,340). The Examiner argues that Matsumura teaches that it is well known in the art to laminate two sheets of a compressible elastomer to one another such that the smooth side of the second layer is affixed to a sheet of reinforcing fabric. In fact, Matsumura teaches that the “reinforcing” fabric be elastic. Further, Matsumura teaches that the compressible layer be porous. In

summary, Matsumura teaches a tape comprising a porous foam layer laminated to an elastic reinforcing layer. The tape lacks fastening means affixed to the outer surface of the compressible layer operable for fastening one edge of the tape to the opposing edge to form a cylindrical tube as taught by the present inventor.

Claims 2, 4, 6 and 8 were rejected under 35USC§103(a) as being unpatentable over Franz '318 in view of Gabbrielli '807 (EP 1216807A2). Briefly, Gabbrielli '807 teaches a method for making a composite layer of material wherein one layer is a fabric having an open weave and the other layer comprises an elastomer wherein the elastomer penetrates and fills the openings in the fabric during the fabrication process. There is no suggestion of an advantage to be gained by affixing fastening means to an outer surface of the laminate.

As noted above, the present inventor teaches a handgrip having fastening means thereon operable for releasably forming a planar sheet of flexible material into a cylindrical tube. The layer of flexible material comprises a compressible sheet having a textured surface and a smooth surface in opposition thereto, the smooth surface being laminated to a sheet of nonextensible reinforcing fabric. In considering the question of obviousness of the claimed invention in view of the prior art relied upon, the applicant submits that the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. The mere fact that the prior art could be combined to provide the instant invention does not make such a combination obvious unless the prior art suggests the desirability of doing so. A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art.

The law requires an applicant to show only that the claimed combination of structure is non-obvious in view of the prior art under Deere. In fact, the CAFC has made it clear that an invention need not operate differently than the prior art to be patentable, but need only be structurally different.

In summary, under Deere (*op.cit*), and as set forth in *MPEP* §706.02, to establish a *prima facie* case of obviousness of a particular claim, the Patent Office must :

- (a) set forth differences in the claim over the applied references;
- (b) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (c) explain why the proposed modification would be obvious.

To satisfy step (c), the Patent Office must identify where the prior art provides a motivating suggestion to make the modifications proposed in step (b). The mere fact that the prior art may be modified as suggested by an examiner does not make the modification obvious unless the prior art suggests the desirability of the modification or combination.

In the present instance the combination of elements; specifically, a wrapping device comprising: (a) a flexible sheet of a compressible closed-cell foam elastomer (i.e., by definition “non-porous”) having a textured, non-slip surface and a smooth opposing surface, said smooth opposing surface being laminated to (b) a sheet of a substantially non-extensible reinforcing fabric to form a laminated sheet; and (c) fastening means affixed to said laminated sheet, said fastening means being operable for releasably attaching opposing ends of said lamintated sheet to form a cylindrical tube, recited in independent claim 1, are different from the elements in the prior art and, moreover, are not suggested by the prior

art. In view of these clarifications regarding the difference between the elements of the present invention and the prior art it is requested that this rejection be withdrawn.

Entry of this amendment, reconsideration, favorable action and early allowance and publication of this application are respectfully requested. If there are any minor matters remaining, it is respectfully requested that the examiner contact the undersigned by phone so that possible minor changes may be discussed in order to expedite the prosecution of this case.

Respectfully,



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by: \_\_\_\_\_

Michael G. Petit